

REMARKS

Claims 1-12 were pending. In the present response, Applicants have amended Claims 1 and 9. No new matter has been added. In summary of the Office Action of January 13, 2003, the Examiner has rejected claims 1-12 under 35 U.S.C. §103(a) as being unpatentable over Wang et al., U.S. Pat. No. 5,237,679, ("Wang"), in view of Schmid et al., U.S. Pat. No. 5,569,164, ("Schmid"), and further in view of Khan et al., U.S. Pat. No. 6,401,206, ("Khan"). Applicants respectfully traverse the Examiner's rejection.

I. The combination of Khan, Wang, and Schmid fails to disclose the claimed invention.

Claim 1, as amended, recites in part:

cryptographically securing the staple data object in response to receipt of the staple instruction, thereby indicating the existence of the association of selected pages and selected documents together at one time. (Emphasis Added).

Claim 9 recites a similar limitation. Applicants respectfully submit that the combination of Khan, Wang, and Schmid fails to disclose at least this element of the claimed invention.

The Examiner agrees with the Applicants that neither Schmid nor Wang disclose any use of cryptography. (Office Action of January 13, 2003, p. 7). Further, Applicants submit that Khan does not disclose or suggest "cryptographically securing the staple data object in response to receipt of the staple instruction, thereby indicating the existence of the association of selected pages and selected documents together at one time." (Emphasis Added).

Khan discloses a "portable digital identity" that "can be used to bind a verifiable electronic impression with an electronic document using electronic watermarks so that any modification in the document . . . can be detected." (Khan, Abstract) (Emphasis

Added). Khan discloses associating an "electronic impression" with a single electronic document to detect tampering. However, Khan does not disclose cryptographically securing a set of documents. As Khan associates a separate electronic impression with each document, Khan cannot suggest using cryptography to indicate "the existence of the association of selected pages and selected documents together at one time," as recited by Claims 1 and 9. As neither Khan, Schmid, nor Wang disclose or suggest all of the elements of the claimed invention, Applicants respectfully submit that Claims 1 and 9, as well as their respective dependent claims, are patentable over the prior art.

II. There is no motivation to modify the teachings of Khan, Wang, and Schmid.

Applicants respectfully submit that there is no teaching or suggestion in the prior art indicating the desirability for "indicating the existence of the association of selected pages and selected documents together at one time," as recited by Claims 1 and 9.

To establish a *prima facie* case of obviousness, MPEP §706.02(j) requires that the Examiner set forth some suggestion or motivation to modify the reference teachings. Further, "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicants disclosure." (MPEP 706.02(j)) (citing In re Vaeck, 947 F.2d 488, (Fed. Cir. 1991)).

As discussed above, Khan discloses associating a digital identity with a single electronic document to detect tampering. Khan does not disclose creating any type of association between documents; consequently, Khan cannot disclose any need or desire for proving the existence of an association of documents at a given time in the past. Therefore, there is nothing in Khan suggesting the modification of the prior art to use cryptography to indicate "the existence of the association of selected pages and selected documents together at one time," as recited by Claims 1 and 9.

Similarly, Schmid does not disclose or suggest any modification to make the claimed invention. Schmid discloses a "method of creating and routing scanned documents," (Schmid, Col. 2, lines 5-6), involving the use of a paper "cover page which

contains both machine and human-readable information." (Schmid, Col. 2, lines 14-16). The machine-readable information on the paper cover page is used to route documents as they are electronically scanned. (Schmid, Abstract). The use of a paper cover page is inherently insecure, as individuals can manually add or remove pages associated with the paper cover page without leaving a trace.

Moreover, Schmid teaches that "matching the unique cover page to a particular document" is undesirable, (Schmid, Col. 2, lines 44-56), and instead suggests "requiring only a single cover page for each user." (Schmid, Col. 2, line 67). Because Schmid associates a cover page with each user, rather than with a specific document or set of documents, Schmid discourages the use of any means for distinguishing one set of documents from any other set of documents from the same user. Therefore, Schmid cannot disclose or suggest any modification of the references to create an indication of "the existence of the association of selected pages and selected documents together at one time," as recited by Claims 1 and 9.

Wang discloses a method for "automatically deleting a temporary document relationship within a data processing system." (Wang, Abstract). Wang teaches that a temporary document relationship can be specified between two or more documents. (Wang, Col. 2, lines 36-39). According to Wang, "each time a document is to be deleted from the data processing system, all relationships of that document are examined to determine if any have been specified as a temporary document relationship," so that "after all documents linked to a selected document are deleted, the selected document itself is automatically deleted by the system." (Wang, Col. 2, lines 39-46). The focus of Wang is on the automatic deletion of temporary document relationships as documents are deleted. The automatic deletion of documents disclosed by Wang is contrary to the stated purpose of the inventions of Claims 1 and 9, which is to indicate "the existence of the association of selected pages and selected documents together at one time."

As neither Khan, Schmid, nor Wang provide any suggestion or motivation to modify the reference teachings to disclose the claimed invention, Applicants respectfully

submit that Claims 1 and 9, as well as their respective dependent claims, are patentable over the prior art.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

The Applicants invite the Examiner to contact the undersigned if the Examiner believes that a telephone conference would expedite prosecution of this application.

Respectfully submitted,

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Date



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